

Appl. No. : 10/039,291
Filed : January 3, 2002

REMARKS

Objection to Use of Term "Kit"

The Examiner has objected to the term "kit" in the claims. Applicant respectfully submits that the term "kit" is an acceptable term and respectfully traverses this objection. However, Applicant has amended the Claims 37-41 to recite "system" instead of "kit," thus rendering this issue moot.

Co-Pending Application Serial No. 10/039291

In response to the Examiner's inquiry regarding Applicant's co-pending Application Serial No. 10/039291, Applicant respectfully submits that Claims 38, 39 and 40 of the current application are patentably distinct from Claims 25 and 26 of Application Serial No. 10/039291. Claims 25 and 26 are directed to a handpiece that is adapted to provide *at least two* different spot sizes for the output beam. By contrast, Claims 38, 39 and 40 of the current application are directed to the unique combination of a light source and a fluoride mouthwash and/or a fluoride patch (*see* Claim 37).

Further, Applicant respectfully submits that the Claims 38, 39 and 40 of the current application are patentably distinct from Claims 12-17 of Application Serial No. 10/039291. Claims 12-17 are directed to a method of treating *unexposed* and *occlusal* surfaces of a tooth. By contrast, Claims 38, 39 and 40 of the current application are directed to the unique combination of a light source and a fluoride mouthwash and/or a fluoride patch (*see* Claim 37).

Accordingly, in view of the above remarks, Applicant respectfully submits that Claims 38, 39 and 40 of the current application are patentably distinct from the cited claims of co-pending Application Serial No. 10/039291.

Home Use

The Examiner notes that Applicant's claims recite a "home treatment" kit or system, but do not recite a protective shield for a user's eyes. Although such a shield is disclosed in an example in the specification (*see* Specification, page 18, Example 10), this example only discloses a *preferred* embodiment. Indeed, the specification explicitly provides that the examples are only "examples of specific embodiments" that are "offered for illustrative purposes only, and are not intended to limit the scope of the present invention in any way." (Specification,

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page 8, lines 13-15). Accordingly, Applicant's claims need not be limited to a preferred embodiment. *See Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations."), *cert. denied*, 490 U.S. 1068 (1989); *Texas Instruments, Inc. v. United States International Trade Commission*, 805 F.2d 1558, 1563 (Fed. Cir. 1986) ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification."). Thus, Applicant respectfully asserts that the pending claims do not need to recite a protective shield.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully asserts that the present application is fully in condition for allowance. If any issues remain that may be addressed by a phone conversation, the Examiner is invited to contact the undersigned at the phone number indicated below. If any matters should remain, the Examiner is invited to contact the undersigned at the telephone number provided below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Sept 27/03

By: Safima A. Merani

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Recognized under 37 CFR § 10.9(b)

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